

REMARKS

A. Background

Claims 1-8 and 10-13 were pending in the application at the time of the Office Action. All of the pending claims were rejected as failing to comply with the written description and as being obvious over cited art. By this response, Applicant has amended claims 1 and 10 and added new claims 14-19. As such, claims 1-8 and 10-19 are presented for the Examiner's consideration in light of the following remarks.

B. Proposed Amendments

Applicant has herein amended claims 1 and 10 to remove the phrase "limited transparency" and clarify what was meant by that phrase. Applicant has also added new claims directed to the jacket that covers the container. The amendments to the claims are supported in the application by prior claim language and by page 3, lines 14-21 of the specification as originally filed. Applicant submits that the amendments to the claims do not add new matter and entry thereof is respectfully requested.

C. Rejection Based on 35 USC § 112

Paragraphs 1 and 2 of the Office Action reject claims 1-8 and 10-13 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the phrase "limited transparency" found in independent claims 1 and 10 is not supported in the specification. Although Applicant disagrees with the assertion of the Examiner, Applicant has herein removed the allegedly offending phrase from independent claims

1 and 10, thereby causing the rejection to become moot. Withdrawal of the rejection is therefore respectfully requested.

D. Rejections Based on 35 USC § 103

1. Rejections based on Cavanagh alone

Paragraphs 3-12 of the Office Action reject claims 1-4 and 11-12 under 35 USC § 103(a) as being obvious over U.S. Patent No. 3,955,020 to Cavanagh et al. ("*Cavanagh*"). Applicant respectfully traverses this rejection. Of the rejected claims, claim 1 is the lone independent claim.

As discussed in a response to a prior Office Action submitted by the Applicant on October 29, 2008, *Cavanagh* discloses a glass container, such as a beverage bottle 1, having a straight (i.e. cylindrical) section 7 which is covered by a plastic laminate 2 to protect the bottle from abrasive forces, to provide decoration, and to prevent the scattering of pieces of the glass container should it be broken. See Abstract. The laminate 2 is extremely thin (3/4 to 5 mils) and held to the bottle by an adhesive layer 30. See col. 5, lines 1-4; and col. 5, line 60 – col. 6, line 7. In fact, *Cavanagh* discloses that this adhesive layer 30 "is an important feature of the ... invention" in part because it will "bond almost any fragment of glass that may result from a breakage of the bottle." Col. 5, lines 60-66. *Cavanagh* further discloses that the non-cylindrical sections of the bottle, i.e., the shoulder 3 and the heel, are covered by plastic films 4 and 10 "to provide more complete protection of the glass bottle." Col. 3, lines 39-40 and 51-61. The plastic films 4 and 10 are either "preformed and shrunk fit" onto the bottle or sprayed or otherwise coated onto the bottle. See col. 3, line 66 – col. 4, line 4.

As noted in the October 29th response, *Cavanagh* teaches that for the plastic films 4 and 10 that cover the shoulder 3 and the heel of the container, the preferred materials are materials used in food packaging because of their clarity and transparency. For example, *Cavanagh* discloses that “[a] particularly desirable film for the cup 10 and cone 4 is ... [made from] SURLYN.” Col. 4, lines 4-6. SURLYN is a material from DUPONT that is widely used in the food packaging industry because of its outstanding clarity and transparency. As such, the heel and shoulder sections of the bottle are desired to be clear.

The plastic laminate 2 that covers the straight section 7 of the bottle consists of two layers - an inner lamina 31 and an outer lamina 32 - with a graphic design 33 applied to the inner surface of the outer lamina 32. See col. 4, lines 41-46. *Cavanagh* discloses that the inner lamina 31 “is opacified in order to render more attractive the graphic design which appears above it.” Col. 2, lines 1-3.

As discussed in the October 29th response, *Cavanagh* expressly teaches that inner lamina 31 is “opaque.” As noted by the Examiner, the meaning of “opaque” is “no light is allowed through.” Applicant notes that the Abstract states that the inner laminate “is generally opaque.” Applicant submits that the meaning of “generally opaque” is virtually the same as “opaque,” discussed above; that is, generally opaque is still opaque, meaning that no light is allowed through. Applicant notes that the term “generally opaque” is only used in the Abstract.

Cavanagh also discloses that if desired, the SURLYN material can be expanded so as to form the inner lamina 31. As such, in all of the embodiments of *Cavanagh*, at least a portion of the container and covering thereof are transparent.

Indeed, the Office Action concedes that an opaque lamina does not cover the entire wall of the container, but asserts that it would have been obvious to modify the *Cavanagh* apparatus

to do so. In the Office Action, the Examiner alleges that “[o]ne of ordinary skill would be motivated to extend the generally opaque lamina to the heel head and shoulders to offer protection against shattering to these areas ... [and] because it would be cost effective...” Office Action, paragraph 29. However, contrary to the assertion of the Office Action, Applicant submits that one of skill in the art would not be motivated to cover the entire wall of the container with an opaque lamina.

It is well known in the art of bottled beverages that the typical consumer desires to view and discern the contents of the liquid that is contained in the container. In this manner, the consumer can verify the color and type of liquid as well as how much liquid is contained within the container. Not only is this information important to the consumer before purchasing the beverage, but perhaps even more so after the bottle has been opened; the consumer can then determine how much liquid remains within the bottle even after one or more portions have been removed and consumed. If the opaque lamina 31 of *Cavanagh* were to cover the entire container wall, the consumer would be prevented from discerning this critical information about the contents within the container. It is perhaps for this reason that *Cavanagh* discloses that transparent SURLYN can alternatively be used to form lamina 31 but does not disclose the opposite, that an opaque lamina 31 can be expanded to cover the shoulder 3 and the heel of the container.

As a result, Applicant submits that contrary to the assertion of the Examiner, one of skill in the art would not modify the *Cavanagh* container to cause the opaque lamina 31 to cover the entire container, as this would prevent the consumer from being able to view the color and other information about the contents of the container, thereby preventing the consumer from discerning this critical information. There is simply no motivation, teaching or suggestion to

cover the entire container of *Cavanagh* with opaque lamina 31 since such a modification would result in a inferior consumer product. Thus, Applicant submits that one of skill in the art would not modify *Cavanagh* to include “a jacket covering the entire container wall. ... [the jacket being] comprised of a material that allows a determination to be made as to whether solid particles or a liquid or a liquid with still undissolved particles are disposed within the container while preventing the actual colour of the contents to be determined when viewing the contents through the jacket,” as recited in amended claim 1.

It is appreciated that the above claimed features provide unique benefits to the applicant’s invention that are not taught in the art. For example, as noted in the specification, the above limitation allows for the safe administration of liquid or freeze-dried galenic formulations in blind clinical trials without compromising the anonymity/blinding requirements of such trials. For instance, a doctor can see when undissolved particles remain in a liquid in the container and thus can know when further dissolving is required, but cannot distinguish between the contents of different containers.

In light of the above discussion, Applicant submits that a *prima facie* case of obviousness regarding claim 1 has not been established at least because the Office Action has failed to show that one of skill in the art would modify the primary reference to include all of the claimed limitations. Accordingly, Applicant respectfully requests that the obviousness rejection of claim 1 be withdrawn. Claims 2-4 and 11-12 depend from claim 1 and thus incorporate the limitations thereof. As such, applicant submits that claims 2-4 and 11-12 are distinguished over the cited art for at least the same reasons as discussed above with regard to claim 1. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claims 2-4 and 11-12 also be withdrawn.

2. Rejection based on the combination of Cavanagh and Norwood

Paragraphs 13-17 of the Office Action reject claim 5 as being obvious over *Cavanagh* in view of U.S. Patent No. 4,281,520 to Norwood (“*Norwood*”). Applicant respectfully disagrees.

As noted in the October 29th response, *Norwood* discloses a portable cooler for keeping a beverage bottle cool. With reference to Figure 1, the cooler includes two identical modules 10 and 12 that each bound half of a cylindrical cavity. The cavity is configured to receive a beverage bottle and has an opening through which a neck of the bottle can pass. Each module 10 and 12 is hollow so that they can each hold a refrigerant liquid which is introduced into the modules through funnel portions 26, 28 (Figure 3) and which are sealed by plugs. *Norwood* discloses that the two modules 10 and 12 are held together by straps that are manually secured.

Applicant presented arguments in the October 29th response as to why it would not have been obvious to modify the continuous wrapping of the laminates in *Cavanagh* into two halves that are hinged together as taught by *Norwood*. Specifically, Applicant argued that this would be difficult and expensive to manufacture, would be time consuming to manually attach, would destroy the benefit of having a continuous laminate encircling and adhered to the bottle which prevents scattering of the glass upon fracture of the bottle, would serve no beneficial function, and would make no improvement. In the present Office Action, the Examiner attempts to refute Applicant’s arguments by simply stating that “regardless of the time and expense, one of ordinary skill in the art ... would be motivated to modify the invention of Cavanagh et al. with that of Norwood because the Norwood reference makes it easier to reuse one cover on bottles of different size and shape.” Office Action, paragraph 30. Applicant respectfully submits that contrary to the assertion of the Examiner, a proper motivation has not been established.

As discussed in the October 29th response, the plastic laminates of *Cavanagh* are applied to new bottles to protect them from scratching during initial packing, shipping and display. Preparation of new bottles is typically an automated process that allows a large number of bottles to be readied. A typical wrapping process, as can be used with *Cavanagh*, can be performed very quickly and automatically in this type of process. To modify the wrapping process to form the laminates of *Cavanagh* out of two halves that are hinged together with straps would be laborious, time consuming, and bog down the whole process. And while the Examiner opines that time and expense are irrelevant, Applicant respectfully disagrees. Time and expense are indeed valid reasons why one would not modify the *Cavanagh* laminates. In fact, the *Cavanagh* reference discloses that cost is indeed a factor. For example, *Cavanagh* discloses that one of the criteria for the lamina is “reasons of economy.” Col. 4, lines 64-65. *Cavanagh* also discloses that one of the benefits of the lamina is that shipment of the bottles can be performed without separators, which reduces the cost of shipping by reducing the weight and volume required to ship a given number of containers. See col. 2, lines 41-48.

Furthermore, as noted above, *Cavanagh* discloses that the adhesion of the laminate 2 to the bottle is an important feature of *Cavanagh*. As such, it is clear that the laminate 2 is not intended to be removed from the bottle to be used on another bottle. One skilled in the art would understand that the bottle of *Cavanagh* with its lamina would either be discarded after use or the entire bottle and lamina would be melted down and recycled. The lamina would never be removed and reused. Thus, the Examiner’s stated motivation is not valid. That is, Although the Norwood reference “makes it easier to reuse one cover on bottles of different size and shape,” this would never be done with the *Cavanagh* laminate.

Applicant submits that a *prima facie* case of obviousness has not been established regarding the combination of *Cavanagh* and *Norwood* for other reasons as well. For example, although the Examiner alleges that it would be obvious to combine *Canavagh* and *Norwood*, the Examiner has failed to set forth how this could be accomplished. As noted above, the laminate 2 of *Cavanagh* is adhered to the bottle. As such, it is not clear how one would also use hinged straps with the laminate. Also, *Cavanagh* discloses that the laminate is extremely thin (less than 5 mils). With this thinness, it is unclear how the hinged straps would be attached to the laminate without tearing the laminate.

Finally, even if, *arguendo*, the *Norwood* insulated cooler were somehow wrapped around the *Cavanagh* bottle, the combination would not include all the limitations of the rejected claim. Claim 5 depends from claim 1 and thus incorporates all of the claim limitations thereof. As the *Norwood* cooler is designed as an insulated cooler that receives a coolant, the cooler is thick and opaque to fulfill this purpose. As such, *Norwood* does not disclose nor suggest a jacket “comprised of a material that allows a determination to be made as to whether solid particles or a liquid or a liquid with still undissolved particles are disposed within the container while preventing the actual colour of the contents to be determined when viewing the contents through the jacket,” as recited in claim 1, from which claim 5 depends.

In light of the above, Applicant submits that a *prima facie* case of obviousness has not been established regarding claim 5 at least because the Office Action has not established a valid motivation to combine the references, the Office Action has not established how the references could be combined, and the Office Action has not shown that the allegedly obvious combination would include all of the limitations of the rejected claim. Accordingly, Applicant respectfully requests that the obviousness rejection of claim 5 be withdrawn.

3. Rejection based on the combination of Cavanagh and Witkowski

Paragraphs 18-27 of the Office Action reject claims 6-8, 10, and 13 as being obvious over *Cavanagh* in view of U.S. Patent No. 5,525,383 to Witkowski ("*Witkowski*"). Witkowski is merely cited for allegedly teaching the inclusion of tape to seal a plastic film. Applicant respectfully traverses this rejection.

Regarding claims 6-8 and 13, those claims depend from claim 1 and thus incorporate the limitations thereof. Applicant submits that *Witkowski* does not cure the deficiencies of *Cavanagh*, discussed above regarding claim 1. That is, notwithstanding the disclosure of *Witkowski*, one of skill in the art would still not modify the *Cavanagh* container to cause an opaque lamina to cover the entire container.

With regard to claim 10, for substantially the same reasons as previously discussed with regard to claim 1, applicant respectfully submits that the combination of *Cavanagh* and *Witkowski* does not disclose or suggest "a jacket covering the entire container wall. ... [the jacket being] comprised of a material that allows a determination to be made as to whether solid particles or a liquid or a liquid with still undissolved particles are disposed within the container while preventing the actual colour of the contents to be determined when viewing the contents through the jacket," as recited in claim 10.

In light of the above, Applicant respectfully requests that the obviousness rejections with respect to claims 5-8, 10, and 13 be withdrawn.

No other objections or rejections are set forth in the Office Action.

D. New Claims

Applicant submits that new claims 14-19 are also distinguished over the cited art. For example, claim 14 is directed to “[a] jacket comprising two half shells hinged to each other, the jacket being configured to be removably put around a transparent container containing a liquid or freeze-dried galenic formulation so as to entirely cover the container, the jacket being comprised of a colored material that causes different colored contents in a container covered by the jacket to take on the same appearance while allowing undissolved particles within the container to be visible when viewed through the jacket.” Applicant submits that for substantially the same reasons set forth above regarding claim 1, none of the cited art teaches or suggests the aforementioned limitation.

Claims 15-19 depend from claim 14 and thus incorporate the limitations thereof. In light of the above discussion, Applicant submits that new claims 14-19 are also distinguished over the cited art.

E. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner’s reconsideration and allowance of claims 1-8 and 10-19 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 2nd day of July 2009.

Respectfully submitted,

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